THIS DISPOSITION IS
NOT CITABLE AS
PRECEDENT OF THE
TTAB

Mailed: 25 OCT 2002
Paper No. 16
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

Trademark Trial and Appeal Board

_____

In re Landmann Wire Rope Products, Inc.

_____

Serial No. 75/723,127

_____

Harris Zimmerman, Esq. for Landmann Wire Rope Products, Inc.

Ann Kathleen Linnehan, Trademark Examining Attorney, Law Office 114 (Margaret Le, Managing Attorney).

_____

Before Seeherman, Chapman and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

Landmann Wire Rope Products, Inc. (applicant) filed an application to register the mark shown below on the Principal Register for “wire rope” in International Class 6.

The application (Serial No. 75/723,127) was filed on June 7, 1999, and it is based on an allegation of a bona fide intention to use the mark in commerce. The mark is lined for the colors red and silver. Applicant describes the mark as consisting of these colors "applied to two adjacent strands of wire rope." Response dated October 6, 2000, p. 1. Applicant also included a statement that explains that the "dotted outline of the goods is intended to show the position of the mark and is not part of the mark." Id.

The examining attorney ultimately refused registration on the Principal Register on the ground that the mark is ornamental and not inherently distinctive under Sections 1, 2, and 45 of the Trademark Act (15 U.S.C. §§ 1051, 1052, and 1127). The examining attorney further noted that applicant has not shown that "its mark has become recognized as an indication of source." Brief, p. 4. The examining attorney argues that under Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 529 U.S. 205, 54 USPQ2d 1065

(2000), "the Supreme Court unequivocally asserted that color marks can never be inherently distinctive." Brief at 2. Since the examining attorney found that applicant's mark was a color mark, albeit one containing two colors, she concluded that applicant's mark could not be registered without a showing that the mark had acquired distinctiveness. Because applicant is not relying on the benefits of Section 2(f) of the Trademark Act, the examining attorney refused registration.

Applicant argues that a reading of the Wal-Mart case indicates that the Court's comment about color was addressed to a question involving a single color. Since applicant's mark involves two colors, applicant submits that the Wal-Mart case does not apply. In addition, applicant maintains that its mark is not a simple color mark. Applicant's mark "weav[es] its red strands and silver strands through the web of the product itself, producing a design." Brief at 4. Finally, applicant includes evidence that colors on wire rope have been recognized as trademarks.

When the examining attorney made the refusal to register final, applicant filed a notice of appeal.

We agree that applicant's mark is not inherently distinctive because the record does not indicate that color

strands applied to wire rope would be immediately recognized as serving a trademark function.

The question of whether color functions as a trademark in the wire rope industry is hardly a new question. See A. Leshen & Sons Rope Co. v. Bascom Rope Co., 201 U.S. 166 (1906) (Question of whether a streak of any color functioned as a trademark for wire rope). More recently, in a case involving the color green-gold for dry cleaning press pads, the Supreme Court explained that "a product's color is unlike 'fanciful,' 'arbitrary,' or 'suggestive' words or designs, which almost *automatically* tell a customer that they refer to a brand." Qualitex Co. v. Jacobson Products Co., 514 U.S. 159, 34 USPQ2d 1161, 1162 (1995) (emphasis in original). The question in that case was whether the Trademark Act "permits the registration of a trademark that consists, purely and simply, of a color." Id. The Court concluded "that, sometimes, a color will meet ordinary legal trademark requirements." Id. In a subsequent case, the Court explicitly held that product "design, like color, is not inherently distinctive." Wal-Mart Stores, 54 USPQ2d at 1068.

However, even before the Qualitex case, marks that consisted primarily of color combinations, such as applicant's mark involved here, were often held to be not

inherently distinctive. While ornamentation is not incompatible with trademark function, "unless the design is of such nature that its distinctiveness is obvious, convincing evidence must be forthcoming to prove that in fact the purchasing public does recognize the design as a trademark which identifies the source of the goods." In re Owens-Corning Fiberglas Corporation, 774 F.2d 1116, 227 USPQ 417, 422 (Fed. Cir. 1985), quoting, In re David Crystal, Inc., 296 F.2d 771, 132 USPQ 1, 2 (CCPA 1961) (registration denied for red and blue bands on white socks). See also Plastilite Corp. v. Kassnar Imports, 508 F.2d 824, 184 USPQ 348, 350 (CCPA 1975) (yellow and orange fishing floats neither inherently distinctive nor registrable under Section 2(f)). Because the record in this case does not lead us to conclude that applicant's mark would be immediately recognized as a trademark, we do not reach the examining attorney's argument that marks consisting of more than one color could never be inherently distinctive.

The design in this case is similar to other color marks that have traditionally been found to be not inherently distinctive. One test for whether a design is inherently distinctive is whether a "buyer will immediately rely on it to differentiate the product from those of

competing manufacturers." In re Hudson News Co., 39 USPQ2d 1915, 1922 (TTAB 1996), aff'd w/o opinion, 114 F.3d 1207 (Fed. Cir. 1997).

The unusual aspect of the case now before the Board is the evidence that color is frequently used to perform a trademark function in the wire rope industry.

> Insofar as the nature of the use of colored strands in the wire products field is concerned, it is not disputed that it is the custom, as previously indicated, for manufacturers to use different colors for application to their wire rope or cable for identification purposes and that purchasers do recognize the individual colors as source indicia. Considering, however, the limited number of primary colors available for use, it is apparent that a new manufacturer of wire rope, if he is to follow the practice in the trade as he has a right to do, is obligated to utilize secondary colors or combinations of colors, as applicant has done, to identify and distinguish his goods in the trade. If the latter course is chosen, it is likely that one of the colors would be that previously adopted and utilized by itself by a competitor on its goods. This color selection process would normally be known to purchasers and prospective purchasers of wire rope who, because of the very character of the product and the uses to which it is generally applied, would be informed and knowledgeable persons making their selection with care and deliberation.

Wire Rope Corp. of America, Inc. v. Secalt S.A., 196 USPQ 312, 315 (TTAB 1977). See also Amsted Industries Inc. v. West Coast Wire Rope & Rigging Inc., 2 USPQ2d 1755, 1757 (TTAB 1987) ("[T]here is no doubt, on opposer's record, that a number of suppliers of wire rope utilize one or more distinctively colored wire rope strands to serve as

indications of origin and have registered these indicia as trademarks").

In addition, applicant has submitted copies of trademark registrations "covering colored strands in wire ropes used as indications of origin, and deemed by the Trademark Office to sufficiently distinguish the various registrants' goods from the other." Brief at 6.

The fact that the industry uses color at times as a trademark does not by itself lead to a conclusion that all combination of colors, and particularly applicant's combination of colors, would be immediately recognized as providing a source identifying function when colored strands are used on wire rope. While applicant has included copies of registrations for color used on wire rope, none of these registrations issued subsequent to the Supreme Court's Wal-Mart decision. Second, even these registrations show that registrations for color on wire rope are not necessarily inherently distinctive. See Registration No. 1,542,056 (Supplemental Register); No. 1,647,858 (Section 2(f)); and No. 2,211,951 (Supplemental Register). See also In re Amsted Industries, Inc., 972 F.2d 1326, 24 USPQ2d 1067, 1067-68 (Fed. Cir. 1992) (orange-sheathed wire rope registered under the provisions of Section 2(f)). In addition, three registrations are

owned by the same company for slight variations of the same mark, white and red filaments wrapped around or wound into the core of the wire rope (Registration Nos. 1,178,813; 1,178,814; and 1,178,815). These registrations also issued contemporaneously and therefore, they do not represent examples of three distinct marks.

The only other evidence of record consists of several pages from a U.S. Army Corps of Engineers publication that notes that domestic wire rope is color coded for easy identification. However, the publication also indicates that the number of U.S. wire rope producers is decreasing and that there are foreign producers of wire rope. The publication does not explain how foreign manufacturers identify their rope or if they use color for only source-identifying purposes.

Because some of the registrations are registered on the Supplemental Register, others have registered on the Principal Register after a showing of acquired distinctiveness, and others are registered on the Principal Register without any Section 2(f) claim, applicant's evidence presents a mixed picture of how color functions in the wire rope industry. In addition, applicant's design is not "of such a nature that its distinctiveness is obvious." Owens-Corning, 227 USPQ at 422. Applicant's design of two

different color strands is not the type of design that purchasers, upon first seeing the colored wire rope, would immediately recognize as a trademark. Consequently, we cannot hold that applicant's color combination mark is inherently distinctive.

Decision: The examining attorney's refusal to register applicant's design on the Principal Register on the basis that it is not inherently distinctive is affirmed.